

REMARKS

This application has been reviewed in light of the Office Action dated August 9, 2005. Claims 7, 8, 10, 12 and 13 are pending in this application, of which Claims 7 and 12 are in independent form. Claims 7 and 12 have been amended to define still more clearly what Applicants regard as their invention; no change in claim scope has been effected. Favorable reconsideration is requested.

Claims 7, 8, 10, 12 and 13 were rejected solely under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,631,014 B1 (Aoshima).

Independent Claim 7 is directed to an image reading apparatus that comprises a scanning member, movable along an original mounting table, that includes a reading element for reading an original image. A frame member of the image reading apparatus, which has a rib, houses the scanning member. A control board is provided for controlling the scanning member, and an interface connector is connected to a signal line of an external apparatus, and is mounted on a side of the control board. Also, according to Claim 7, the control board is secured to the frame member at least at one side on which the interface connector is not mounted, and the control board is secured to the rib of the frame member.

Among other notable features of Claim 7 is a frame member of the image reading apparatus, which has a rib, housing the scanning member. The Office Action asserts that the recited rib is inherently disclosed in Aoshima. Applicants respectfully disagree. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing being described in the reference, and that it would be so recognized by persons of ordinary skill in the art. See MPEP § 2112; In

re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999). Inherency, however, may not be established by probabilities or possibilities. Id. Further, in relying on the theory of inherency, a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art must be provided. See MPEP § 2112; Exparte Levy, 17 U.S.P.Q. 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Citing column 4, lines 3-19 and 49-62 of Aoshima, the Office Action asserts that it “is inherent for the rib to be held within the frame of Aoshima, as the frame is where the control board 14 is secured. The circuit board 15 is attached to the scanning unit 3, which is attached to the guide shaft 4 that is attached to the body frame 1.” Office Action, p. 2. Further, the Office Action states that Fig. 2 shows “in clear detail” the rib device. Id.

The cited portions of Aoshima, however, merely state, among other things, that a guide shaft 4 has its two ends fixed to the body frame 1, and that a control circuit 15 has one end connected to the scanning unit 3 which is fittingly engaged to the guide shaft 6. Nothing in those passages teaches or suggests, either expressly or inherently, “a frame member of said image reading apparatus housing said scanning member, having a rib,” as recited in Claim 7 (emphasis added). Further, nothing in Figure 2 even hints of a rib, as recited in Claim 7.

In addition, the portions of Aoshima cited by the Examiner as disclosing the recited securing of the control board to the rib, states that control circuit 14 is attached to the bottom surface of a body frame 1, and discusses the arrangement of flexible printed circuit board 15; nothing in that passage, however, relates to any structure that is believed

to teach or suggest a rib as recited in Claim 7, and for at least that reason, Claim 7 is believed to be clearly allowable over Aoshima.

Independent Claim 12 is directed to an image reading apparatus that comprises a scanning member, movable along an original mounting table, and which includes a reading element for reading an original image and has a frame. A drive source is provided for driving the scanning member, and a frame member of the image reading apparatus houses the scanning member. Also provided is an interface connector connected to a signal line of an external apparatus and mounted on an inside side surface of the frame member, the inside side surface of the frame member being located at the end of a drive direction of the scanning member. In addition, according to Claim 12, the drive source is located at a side surface of the frame of the scanning member in such manner as to move together with the scanning member, and when the scanning member is positioned at the end of a driving movable range on the side at which the drive source is located, the drive source and the interface connector are positioned between the side surface of the frame member and the scanning member, and the drive source is recited as not overlapping with the interface connector in a direction perpendicular to the original mounting table surface.

The Office Action appears to cite column 4, lines 10-45 of Aoshima as disclosing the structural features recited in the various “wherein” clauses of Claim 12. Applicants respectfully disagree. At the very least, nothing in Aoshima teaches or suggests a drive source located at a side surface of the frame of the scanning member, as recited in Claim 12. This is clearly established by Figures 2 and 3. Accordingly, withdrawal of the rejection of Claims 12 also is respectfully requested.

Moreover, as noted in the Amendment dated May 16, 2005, as Aoshima is commonly assigned with the present application, it is prior art only under one or more of §§ 103(e), (f) and (g), and was pending (as is the present application) after November 29, 2000, and accordingly is prior art only for purposes of anticipation, and cannot be relied upon to make out a rejection for obviousness. Moreover, the priority dates of the present application are earlier than the February 7, 2000, effective date of Aoshima as prior art; while sworn translations of those priority applications have not been submitted, Applicants' entitlement to benefit of those priority dates with respect to the present claims is believed to be clear even from the drawings of the priority applications.

A review of the other art of record has failed to reveal anything which, in Applicants' opinion, would remedy the deficiencies of the art discussed above, as a reference against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or the other of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

This Amendment After Final Action is believed clearly to place this application in condition for allowance and its entry is therefore believed proper under 37 C.F.R. § 1.116. Entry of this Amendment After Final Action, as an earnest effort to advance prosecution and reduce the number of issues, is respectfully requested. Should the Examiner believe that issues remain outstanding, the Examiner is respectfully requested to

contact Applicant's undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "L.P. Diana", written over a horizontal line.

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